

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1, 2, 4, 7-9, 11, 14-16, 18, and 20-31 are pending. Claims 3, 5, 6, 10, 12, 13, 17, and 19 were previously cancelled.

Claims 1, 2, 4, 7-9, 11, 14-16, 18, and 20-23 remain as previously presented, and claim 24-31 are added. Claims 1, 8, 15, and 22 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 18, 19, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chui et al. (U.S. Patent 6,657,702) in view of Fredlund et al. (U.S. Patent 6,154,295), and further in view of alleged well known prior art; and claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chui et al. in view of Fredlund et al., and Souissi et al. (U.S. Patent 6,556,817).

These rejections are respectfully traversed.

Arguments Regarding Independent Claims 1, 8, 15, and 22 as Previously Presented

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, each of independent claims 1, 15, and 22 as previously presented recites a combination of features, include *inter alia*

“accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data”, and “extending the predetermined storage period for the image data for which the order was placed”.

In addition, independent claim 8 as previously presented recites combination of elements, including *inter alia*

“wherein the server is adapted to store the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and to receive the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data”, and “wherein the server is further adapted to extend the predetermined storage period for the image data for which the order was placed”.

The Applicant respectfully submits that the combination of features set forth in each of independent claims 1, 8, 15, and 22 is not disclosed or made obvious by the prior art of record, including Chui et al., Fredlund et al., and Soussi et al., and that which is allegedly well known in the art.

Chui et al. appear to teach a customer may order photographic services via a user terminal and network. However, in the rejection of claims 1, 8, and 15 (see page 4 of the Office Action) the Examiner concedes that Chui et al. fail to disclose either a server setting a predetermined storage period, or the server extending the predetermined storage period for the image data for which the order was placed.

The Examiner then refers to a physical ordering system disclosed in Fredlund et al., alleging that Fredlund et al. make up for the deficiency of the network-based ordering system disclosed by Chui et al.

As will be discussed below in detail, Fredlund et al. fail to disclose any on-line interaction whatsoever between a customer computer terminal and a server via a network, and instead merely disclose a manual process for transferring film and ordering prints (which, unlike the present invention, is done at the same time), and merely disclose paper-based instructions for inviting a customer to optionally request an extended storage period.

Thus, the Applicant submits that Fredlund et al. and Chui et al. are non-analogous, and should not be combined to reject the claims of the present application. However, even if Fredlund et al. were to be combined with Chui et al, the combination fails to teach or suggest the present invention.

For example, a careful review of Fredlund et al. column 3, lines 15-54 indicates that Fredlund et al. merely disclose "... a customer sends a roll of film to a processing lab" or takes the film to a "drug store or supermarket for sending the film to the photoprocessing lab..." .
Developed film 18, and prints are returned to the customer... . Instructions 38 may be included with the customer order... . Instructions 38 may be printed out using a coupon printer³⁹ connected to computer 26. The customer is instructed ... that by calling, for example, a 1-800 number, they can ... have the digital file ... extended for a certain period of time, such as a month. "

The Fredlund et al. system and process are completely different from that set forth in independent claims 1, 8, 15, and 22 of the present invention.

Fredlund et al. fail to teach an on-line image transfer or print ordering process. Instead, Fredlund et al. merely teach that when ordering prints, the customer orders prints at the time of physically transferring a roll of film to a photoprocessing lab. Printed instructions on a coupon are provided to the client when he receives prints that were previously physically transferred to a processing lab. (The data files are then stored for some period of time, apparently in computer 26.) After receiving the coupon, the customer has the option of manually calling a 1-800 number to have the storage period of their data files extended for a certain period of time. The incoming 1-800 call from the customer is answered either by an operator or a voice answering system 42. Fredlund et al. fail to specifically teach how a 1-800 number call to an operator or a voice answering system brings about an extension of the storage time of the data files on computer 26.

While Fredlund et al. disclose a computer 26, it is the incoming 1-800 number call from the customer that determines whether or not the storage time is extended beyond a predetermined storage time. In addition, only if a customer places a 1-800 number call after receiving a coupon, is there any possibility that the storage time is extended beyond the predetermined storage time.

By contrast, in the present invention, the order may be placed at a time different from the time of transferring the images, and the step extending the predetermined storage period for the image data causes the server to perform a subsequent further step of writing a

message on the user terminal containing information that the predetermined storage period has been extended by the server. In contrast to the method disclosed by Fredlund et al., with the present invention, no action is made by the customer to extend the storage period, other than to order the prints in the first place.

Fredlund et al. merely disclose a system and method providing the customer the option to calling a 1-800 number for requesting an extension of time at a time after the prints have been ordered, printed and returned to the customer.

However, the act of manually placing an order for the prints, as disclosed by Fredlund et al., has no relation whatsoever to whether or not the customer of Fredlund et al. optionally chooses to call a 1-800 number at some time in the future to request that the image storage time be extended.

Moreover, Fredlund et al. are silent about "writing a predetermined storage period of the image data in tag information of the image data, extending the predetermined storage period for the image data for which the order was placed", as set forth in independent claim 22.

In summary, Fredlund et al. fail to disclose any on-line interaction whatsoever between a customer computer terminal and a server via a network, and instead merely disclose a manual process for transferring film and ordering prints (which is done at the same time), and merely disclose a paper-based instructions for inviting a customer to optionally request an extended storage period at a future time after the previously ordered prints have been delivered to the customer. By contrast, in the present invention, the transferring and ordering are done on-line

(and optionally at different times), and the server initiates an action to extend the storage period upon receipt of the print order.

Regarding the Examiner's unsubstantiated allegation (Page 6 of the Office Action) that having a customer use a web interface to extend a storage time is commonly known in the art, the Applicant respectfully submits that, even if this unsubstantiated allegation were true, the Examiner's allegation is irrelevant.

In the present invention, it is the server that extends the storage time of the image file(s) once an order has been placed, whether or not the orders are placed at the same time as transferring the images. In the present invention, the customer does not use either a 1-800 number or a web interface to extend the storage time. The customer is not involved in extending the storage period. Instead, the extension is made automatically by the server without any action by the customer to extend the storage period.

The Examiner cites Souissi et al. merely to teach "time of day differences in communications costs."

As the Examiner knows well, to establish a *prima facie* case of obviousness, three basic criteria must be met.

- 1.) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2.) Second, there must be a reasonable expectation of success.
- 3.) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As set forth in section 2143 of the M.P.E.P., the following are examples of basic requirements of a *prima facie* case of obviousness:

“The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.”

One of these exemplary rationales that may support a conclusion of obviousness set forth in subparagraph “C” relates to use of known technique to improve similar devices (methods, or products) in the same way.

“To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a “comparable” device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices (methods,

or products) has been made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a “base” device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art. The Supreme Court in *KSR* noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.” (*emphasis added*)

The Applicant respectfully submits that the Examiner has failed to articulate each and every one of items (1) to (4) above as is required.

Another of these exemplary rationales that may support a conclusion of obviousness set forth in subparagraph “G” relates to use Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art Reference Teachings To Arrive at the Claimed Invention.

“To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. "[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references." *Id.* at 1368, 80 USPQ2d at 1651".

The Applicant respectfully submits that the Examiner has failed to articulate each and every one of items (1) to (3) above as is required.

In view of the above, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

At least for the reasons described above, Applicant respectfully submits that the novel combination of features set forth in each of independent claims 1, 8, 15, 22 as previously presented is not disclosed or made obvious by the prior art of record, including Chui et al.,

Fredlund et al., and Souissi et al., and that which is well known in the art. Therefore, independent claims 1, 8, 15, and 22 as previously presented are in condition for allowance.

Dependent Claims

The Examiner will note that dependent claims 24-31 have been added.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

Added Dependent Claims 24-27

Each of added dependent claims 24, 26, and 27 recites “wherein the step of extending the predetermined storage period by the server is initiated by the step of receiving the order for the print of the image data”.

In addition, added dependent claim 25 recites “wherein the server is further adapted to extend the predetermined storage period upon receipt of the order for the print of the image data”.

In contrast to the method disclosed by Fredlund et al., with the present invention, no action is made by the customer to extend the storage period, other than to order the prints in the first place.

Fredlund et al. merely disclose a system and method providing the customer the option to calling a 1-800 number for requesting an extension of time at a time after the prints have been ordered, printed and returned to the customer.

However, the act of manually placing an order for the prints, as disclosed by Fredlund et al., has no relation whatsoever to whether or not the customer of Fredlund et al. optionally chooses to call a 1-800 number at some time in the future to request that the image storage time be extended.

Added Dependent Claims 28-31

Each of dependent claims 28 and 30 recites “the step of extending the predetermined storage period for the image data causes the server to perform a subsequent step of: writing a message on the user terminal containing information that the predetermined storage period has been extended by the server”.

In addition, dependent claim 29 recites “wherein the server is further adapted to write a message on the user terminal containing information that the predetermined storage period has been extended by the server upon receipt of the order for the print of the image data”.

Further, dependent claim 31 recites “wherein the step of receiving the order for the print of the image data stored in the server causes the server to perform a subsequent step of: writing a message to be displayed on the user terminal containing information that the predetermined storage period has been extended by the server”.

As discussed above, the Examiner has conceded that Chui et al. fail to disclose either a server setting a predetermined storage period, or the server extending the predetermined storage period for the image data for which the order was placed.

Further, Fredlund et al. merely disclose a method to call a 1-800 number to extend the storage period, and this document fails to provide any hint or suggestion of a server that either

writes a message on the display of the user terminal containing information that the predetermined storage period has been extended by the server, or

writes a message on the user terminal containing information that the predetermined storage period has been extended by the server subsequent to the step of extending the predetermined storage period, as set forth, respectively, in added dependent claims 28-31.

All pending claims are now in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

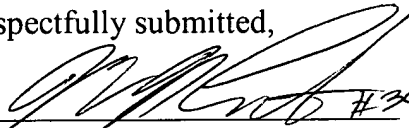
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Dated: June 4, 2008

Respectfully submitted,

By  #39,991
c. Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant